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Supreme Court of the United States

OCTOBER TERM, 1979

No. 79-684

THE VISION CENTER,
Petitioner

versus

OPTICKS, INC., WILL ROSS, INC.
and G. D. SEARLE & CO.,
Respondents

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

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THE VISION CENTER,
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OPTICKS, INC., WILL ROSS, INC.,
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Respondents.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

Petitioner prays that a writ of certiorari issue to review the judgment herein of the United States Court of Appeals for the Fifth Circuit entered in the above-entitled case on May 23, 1979, petition for rehearing denied on August 1, 1979.

OPINIONS BELOW

The opinion of the District Court, granting a preliminary injunction to Petitioner (hereinafter some-

times referred to as "The Vision Center"), with detailed findings of facts and conclusions of law, is reported at 461 F.S. 835 and is reproduced as Appendix D, pp. 23a-41a. The Court of Appeals reversed the District Court with instructions that the preliminary injunction be dissolved and that an order issue requiring Respondents to place the identifying prefix "Pearle" before the phrase "Vision Center" on all its signs and advertisements in the New Orleans area. The opinion of the Court of Appeals is reported at 596 F.2d 111 and is reproduced as Appendix A, pp. 1a-19a, and the order denying rehearing appears as Appendix C, pp. 21a-23a.

JURISDICTION

The opinion and judgment of the United States Court of Appeals was entered May 23, 1979. Petition for rehearing was denied on August 1, 1979. Jurisdiction of this Court is invoked under 28 U.S.C. §1254(1).

QUESTIONS PRESENTED

1. Whether the opinion below failed to consider the controlling issue of a trade name case — the likelihood of confusion between the names, and whether the opinion below violates the guidelines in *Hanover Star Milling Co. vs. Metcalf*, 240 U.S. 403 (1916), in which this Court held that the trade name "Hanover Tea Rose" was entitled to protection by injunction against use of the similar name "Steeleville Tea Rose".

2. Whether the findings of the District Court should have been sustained inasmuch as (i) the name "The Vision Center" was entitled to trade name protection because, as held in *American Trading Co. vs. H. E. Heacock Co.*, 285 U.S. 247 (1932), of its long use in the local market, (ii) the name "The Vision Center" had acquired a secondary meaning in its market area and (iii) because those findings were not clearly erroneous.

3. Whether the holding in the opinion below, that under Louisiana law actual fraud must be established before a trade name may be protected is erroneous and if permitted to stand will cause uncertainty and confusion in the law governing protection of trade names.

STATUTE INVOLVED

Federal Rules of Civil Procedure, Rule 52(a) provides:

> ". . . Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge the credibility of the witnesses. . ."

STATEMENT OF THE CASE

The Vision Center sued in state court in Louisiana for injunction against Respondents' use of the word combination "Vision Center" in any part of Respondents' trade name. After the case was removed, the United States District Court for the Eastern District of

Louisiana, on August 25, 1978, enjoined Respondents' use of the combination of the words "Vision" and "Center" in their trade name and submitted supporting Findings of Fact and Conclusions of Law. It is the reversal by the United States Court of Appeals for the Fifth Circuit of this injunction which is the subject of this petition for certiorari.

The Vision Center started using that trade name in the New Orleans area in May 1955, at which time it registered the name under the Louisiana Trademark Law. The registration has been successively renewed since that date.

Since 1955, The Vision Center has placed its name before the public to the maximum extent allowed by the ethics of the optometric profession. Thus, it has used the name on eyeglass cases, lens wipers, lens cleaning solution, announcements, telephone book yellow pages, letterheads, direct mailing materials and the like. After media advertising became permissible by Louisiana optometrists in early 1978, The Vision Center engaged in extensive promotion of its name.

Until Respondents entered the New Orleans marketing area, no one other than The Vision Center had used the combination of words "Vision Center". In at least three prior instances, The Vision Center was successful in having competing firms change their trade names so as not to use the words "Vision Center" in combination.

On trial of the instant case, The Vision Center established that there was actual confusion of identity between itself and some of Respondents' Pearle Vision Centers located in other areas, and that use by Respondents of the name "Pearle Vision Center" would confuse customers and potential customers in the New Orleans area. Some of Respondents' establishments in other locations used eyeglass cases and signs which were imprinted with the words "Vision Center", without the identifying name "Pearle". Also Respondents' national television commercials (which were intended for use in the New Orleans area) and advertisements in magazines contained the words "Vision Center" without the prefix "Pearle".

Respondents unsuccessfully tried to purchase Petitioner and thereafter opened their establishments in New Orleans in close proximity to Petitioner's existing establishments. Each of Respondents' establishments featured large exterior signs with the name "Pearle Vision Center" prominently displayed, and advertised themselves in the telephone book, directly under petitioner's listing, as "VISION CENTER PEARLE-See Pearle Vision Center".

REASONS FOR ALLOWING THE WRIT

1.

The decision below, both in failing to consider the issue of likelihood of confusion and

in holding that the addition of a prefix to a trade name absolves the user from findings of deception and unfair competition, conflicts with the guidelines set forth by this Court in *Hanover Star Milling Co. vs. Metcalf*, 240 U.S. 403 (1916), as well as with decisions of the other Circuits and the Fifth Circuit's own earlier holdings.

Certiorari should be granted to review the Appellate Court's holding that, despite the District Court's findings of fact to the contrary, the evidence "falls short of establishing that in the mind of the consuming public the primary significance of the term 'Vision Center' is 'not the product but the producer'." 596 F.2d at 118.

The controlling issue in a trade name case is whether the use of a similar name is likely to cause confusion. *Scarves by Vera, Inc., vs. Todd Imports, Ltd., (Inc.)*, 544 F.2d 1167 (CA 2-1976); *Continental Motors Corp. vs. Continental Aviation Corp.*, 375 F.2d 857 (CA 5-1967); *Tisch Hotels, Inc. vs. Americana Inn, Inc.*, 350 F.2d 609 (CA 7-1965); *Safeway Stores Inc. vs. Safeway Properties, Inc.*, 307 F.2d 495 (CA 2-1962). The District Court found actual confusion between Petitioner's trade name and Respondents' trade name, and also found that there would be likelihood of confusion between the names. The Court of Appeals failed to consider these crucial findings.

The addition of a prefix does not absolve the user from findings of deception and unfair competition.

In *Hanover Star Milling Co. vs. Metcalf*, 240 U.S. 403 (1916), this Court was faced with whether the trade name "Hanover Tea Rose" should be protected against the competing name "Steeleville Tea Rose", and held that:

> ". . . The mere substitution of 'Steeleville' in the place of 'Hanover' on the labels is not convincing either that the intent was innocent or that the result will be innocuous, since it is accompanied with the words 'Tea Rose' . . ." (240 U.S. at 424).

Similarly, in *World Carpets, Inc. vs. Dick Littrell's New World Carpets*, 438 F.2d 482 (CA 5-1971), the trade name, "World Carpets" was protected against use of the name "New World Carpets", because there was a likelihood of confusion between the two names. The court in the *World Carpets* case also emphasized that the prior user of the name had a right to be defended against the marketing of a lower or different grade or standard of product by the competitor and the resulting possible loss of reputation.

In *Jenkins Publishing Co. vs. Metalworking Publishing Co.*, 315 F.2d 955 (CCPA-1963), the court protected the term "METALWORKING" as against "WESTERN METALWORKING", because the addition of the prefix did not eliminate likelihood of confusion.

Respondents' use of the word "Pearle" as a prefix does not absolve it from the likelihood of confusion of its name with that of The Vision Center.

2.

The decision below, in failing to protect a local first user's trade name and in holding that secondary meaning cannot be established through long usage, conflicts with this Court's decision in *American Trading Co. vs. H. E. Heacock Co.*, 285 U.S. 247 (1932), and with decisions of the other Circuits.

It is undisputed that The Vision Center was first to employ its trade name in the New Orleans market and therefore had the prior right to use that name in that market. *United Drug Co. vs. Theodore Rectanus Co.*, 248 U.S. 90 (1918); *The Dynasty Room, Inc. d/b/a Whiskey A-Go-Go vs. Whiskey A-Go-Go, Inc.*, 186 So.2d 402 (La. App. 4-1966).

Moreover, the name "The Vision Center", is capable of full trade name protection. In fact, Respondents themselves secured from the United States Patent Office a federal trademark of the name "Vision Center", the very mark which they now challenge as invalid. A federally registered trademark is *prima facie* evidence that the mark is distinctive. *Abercrombie & Fitch Co. vs. Hunting World, Inc.*, 537 F.2d 4 (CA 2-1976); *Union Carbide Corp. vs. Ever-Ready, Incorporated*, 531 F.2d 366 (CA 7-1976).

In *American Trading Co. vs. H. E. Heacock Co.*, 285 U.S. 247 (1932) it was held that because of the first user's long use in the local market of the name "Rogers" on

silverware, the local first user had acquired valuable goodwill, and the name identifying its wares had become distinctive and was entitled to trade name protection.

The District Court held that over a long period of time the name "Vision Center" had become at least suggestive of Petitioner's business establishments, and also that through Petitioner's efforts, the name "Vision Center" had acquired a secondary meaning in the minds of the public. When this occurs, the name is entitled to trade name protection. *Kellogg Co. vs. National Biscuit Co.*, 305 U.S. 111 (1938). Such a holding is a factual holding and will not be disturbed unless clearly erroneous. *Volkswagenwerk, AG vs. Rickard*, 492 F.2d 474 (CA 5-1974); FRCP Rule 52(a). Similarly, in *Standard International Corp. vs. American Sponge and Chamois Co.*, 394 F.2d 599 (CCPA-1968), the name "DUST 'N WAX" was protected by precluding use of the competing name "DUST 'N GLOW".

The Appellate Court erred in holding that secondary meaning could not be established by long usage. *Safeway Stores, Inc. vs. Safeway Properties, Inc.*, 307 F.2d 495 (CA 2-1962); *G. & C. Merriam Co. vs. Saalfield*, 198 Fed. 369 (CA 6-1912), aff'd and modified, 238 Fed. 1 (CA 6-1917), cert. denied 243 U.S. 651 (1917); and *American Trading Co. vs. H. E. Heacock Co., supra.*

3.

The holding of the Court below, that actual fraud must be established before a trade name

may be protected, is contrary to all law governing protection of trade names, and, unless reversed, will cause uncertainty and confusion in the law governing trade name protection.

The Court of Appeals acknowledges that both The Vision Center and Respondents "relied on federal precedents as announcing generally accepted principles of substantive trademark law". 596 F.2d at 115. The Court then discussed Louisiana authorities, which it erroneously read as requiring that actual fraud must be proven before use of a competing trade name may be enjoined. 596 F.2d at 117 (fn. 16), 118-9. The Court relied on *Straus Frank Co. vs. Brown,* 246 La. 999, 169 So.2d 77 (1977), and mistakenly failed to consider the Louisiana court's statement in that case, that fraud can be reasonably inferred.

The Court below failed to consider the authorities that hold an infringer's conduct can "amount to fraud" and be "tantamount" to fraud, which meets a fraud standard. *T.G.I. Friday's Inc. vs. International Restaurant Group, Inc.,* 569 F.2d 895 (CA5-1978), aff'g 405 F.S. 698 (M.D. La.-1975).

There is ample evidence to support the District Court's holdings that Respondents' conduct amounted to and was tantamount to fraud and from that conduct fraud can be reasonably inferred. Respondents tried unsuccessfully to purchase The Vision Center,

advertised themselves in the telephone directory pages as "VISION CENTER PEARLE-See Pearle Vision Center", located their stores in close proximity to those of The Vision Center and utilized large signs featuring the words "Vision Center" in combination.

The discussion of the Louisiana authorities in the opinion of the Court below drives a wedge between the law of trade names as enforced throughout the United States from that as enforced in Louisiana, a wedge not justified by the Louisiana authorities. As held in *Handy vs. Commander,* 49 La. Ann. 1119, 22 So. 230 (1897), Louisiana long ago adopted the Federal common law of trade marks and trade names. It is submitted that a close reading of the Louisiana cases clearly shows that the court below has misread those cases.

CONCLUSION

If the opinion of the Court below is allowed to stand, the result on the law of trade names will be devastating. Local prior users of trade names will have little or no protection against giant competitors who enter their market areas with confusingly similar names. The opinion of the Court below is contrary to uniformly controlling decisions on the questions presented.

For the reasons assigned, Petitioner respectfully submits that this petition for certiorari should be granted.

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CERTIFICATE

It is certified that copies of the foregoing petition were served on Respondents this date by mailing same to their counsel of record as required by Rule 33-1 of this Court.

New Orleans, October ____, 1979.

William W. Messersmith, III

APPENDIX

APPENDIX "A"

THE VISION CENTER,
Plaintiff-Appellee,
Cross Appellant,

versus

OPTICKS, INC., Will Ross, Inc., and
G. D. Searle & Co.,
Defendants-Appellants,
Cross Appellees.

No. 78-2867

United States Court of Appeals,
Fifth Circuit

May 23, 1979

Rehearing Denied Aug. 1, 1979

Appeals from the United States District Court for the Eastern District of Louisiana.

Before THORNBERRY, AINSWORTH and MORGAN, Circuit Judges.

LEWIS R. MORGAN, Circuit Judge:

This is an expedited appeal from an order of the district court granting a preliminary injunction which pre-

vents Opticks, Inc.,[1] a Texas corporation, from using the trade name "Pearle Vision Center" in the New Orleans market area. The Vision Center,[2] a Louisiana partnership, claimed that Opticks' proposed use of the words "vision" and "center" constituted trade name infringement and unfair competition. The action was originally filed in state court and was removed to federal court on the basis of diversity jurisdiction. The district court[3] found that the name "vision center" was either suggestive of the partnership's services or, if descriptive, had acquired a secondary meaning. Moreover, the court concluded that Opticks' conduct was tantamount to fraud. Opticks insists that these findings are clearly erroneous and argues that the district court erred in granting a preliminary injunction affording trade name protection to the phrase "vision center." We agree and therefore reverse the district court.

I.

The phrase "vision center" was first used in the New Orleans area in 1955 when Dr. Ellis Pailet, a New

1 Both Opticks, Inc. and Will Ross, Inc. are subsidiaries of G. D. Searle & Co., a Delaware corporation with its principal place of business in Skokie, Illinois. Although all three corporate entities are appellants in this action, we will refer to them collectively as "Opticks."

2 Because this appeal involves a construction of the words "vision center," we will, in an effort to forestall possible confusion, avoid calling plaintiff "The Vision Center" but will refer to it as the "partnership."

3 The court's decision granting plaintiff's motion for a preliminary injunction is reported at 461 F.Supp. 835.

Orleans optometrist, adopted it as the name of his sole proprietorship. Subsequently, Dr. Pailet hired additional optometrists and in 1967 formed a partnership which continued, without interruption, to use "The Vision Center" name. That partnership is the plaintiff in this action. The partnership has six locations in the New Orleans area, all operating under the name "The Vision Center."

Dr. Pailet first registered the trade name with the Secretary of State of Louisiana under the Louisiana Trademark Law on April 19, 1955.[4] That registration was renewed in March 1965 and again in February 1975. Over the years, the partnership engaged in the limited advertising permitted under the ethics of the optometric profession and, with a change in the law in 1978, began media advertising in newspapers, magazines, and on the radio.

In 1969, Opticks acquired a New York Company which had dispensed optical goods and services since 1952 under the name "Vision Center." Opticks then began to operate similar stores using this name and, at present, operates a national chain of retail outlets for optical services and goods under the trade names "Vision Center," "Pearle Vision Center," "Rogers Vision Center," and "Hillman-Kohan Vision Center."

4 La.R.S. 51:211 *et seq.* At present, no one else in the New Orleans market area uses the combination of words "vision" and "center." On three separate occasions the partnership persuaded other optical firms planning to use these words to change their trade names to some other name. No legal action was necessary on any of these occasions.

On July 28, 1970, Will Ross, Inc. registered the words "vision center" as both a service mark and a trademark on the principal register of the U.S. Patent Office. Will Ross later assigned its rights in these marks to Opticks.

During 1977 Opticks formulated a plan to open three outlets in the New Orleans area under the name "Pearle Vision Center."[5] Opticks planned to identify its stores by a large green exterior sign showing the words "Pearle Vision Center" in large white letters, with "Pearle" being the largest word. In promoting its new stores, Opticks also planned to use its national advertising program and materials, including television and radio commercials, newspaper advertisements, and direct mail flyers. Although a percentage of Opticks' consumer-oriented advertising materials used in other parts of the country employs the words "Vision Center," without an identifying prefix, the advertising slated for use in New Orleans always used the words "Pearle Vision Center."[6] The partnership

5 Opticks was aware of the existence of "The Vision Center" and, at one point, initiated negotiations to purchase the partnership. The partners considered Opticks' offer but declined to sell.

6 The district court found that Opticks had used the words "Vision Center" on certain of its eyeglass cases and had exhibited no intention to abandon such use. The record indicates, however, that the partnership obtained the eyeglass case introduced as an exhibit from Opticks' Biloxi, Mississippi store, and the partnership offered no proof that any materials without the identifying prefix "Pearle" would be used in New Orleans. Absent evidence to the contrary, the district court should have accepted Opticks' assertion that all of its New Orleans advertising will employ the words "Pearle Vision Center" and that it will not use the words "Vision Center" without the identifying prefix.

brought suit, and on August 25, 1978, the district court entered a preliminary injunction enjoining Opticks from using any combination of the words "vision" and "center" in the New Orleans area.

II.

The granting or denying of a preliminary injunction rests in the sound discretion of the district court, and its decision will be overturned only for abuse. *Johnson v. Radford,* 449 F.2d 115 (5th Cir. 1971). A preliminary injunction is an extraordinary remedy, however, and the boundaries within which the district court must exercise its discretion are clearly marked. *State of Texas v. Seatrain International, S.A.*, 518 F.2d 175 (5th Cir. 1975); *Canal Authority v. Callaway,* 489 F.2d 567 (5th Cir. 1974). The district court should issue the injunction only if the moving party clearly satisfies what we have recognized as the four prerequisites to such relief.[7] These are: (1) a substantial likelihood that the movant will ultimately prevail on the merits; (2) a showing that the movant will suffer irreparable injury unless the injunction issues; (3) proof that the threatened injury to

7 The partnership contends that the standard for appellate review of the granting of a preliminary injunction recognized in our opinions is inapplicable in a trade name case. We disagree. In *Compact Van Equipment Co. v. Leggett & Platt, Inc.*, 566 F.2d 952 (5th Cir. 1978), a patent infringement and unfair competition case, we examined the district court's granting of a preliminary injunction in the light of these four prerequisites. A trade name infringement case does not require a different standard. *See, e.g., Scientific Applications, Inc. v. Energy Conservation Corp.*, 436 F.Supp. 354 (N.D.Ga. 1977).

the movant outweighs whatever damage the proposed injunction may cause the opposing party; and (4) a showing that the injunction, if issued, would not be adverse to the public interest. *Seatrain, supra,* 518 F.2d at 179, and cases cited therein. The remedy should not be granted unless the movant carries the burden of persuasion concerning all four of these criteria.

Because removal to federal court was premised entirely upon diversity of citizenship, we look to state substantive law in assessing the merits of both the trade name infringement and unfair competition claims. The fact that Opticks' Lanham Act registration may be a defense to a state trade name infringement claim affords no basis for original federal question jurisdiction.[8] *Gully v. First Nat'l Bank,* 299 U.S. 109, 57 S.Ct. 96, 81 L.Ed. 70 (1936); *La Chemise Lacoste v. Alligator Co.,* 506 F.2d 339 (3rd Cir. 1974). Although we apply Louisiana law, we note that both parties have relied on federal precedents as announcing generally accepted principles of substantive trademark law. Except where we discern a difference between local law and the general law on the subject, we will also employ relevant federal decisions. *See Kellogg Co. v. National Biscuit Co.,* 305 U.S. 111, 113 n. 1, 59 S.Ct. 109, 83 L.Ed. 73 (1938).

III.

The threshold question in any trade name infringement action is whether the word or phrase was initial-

8 It is clear that Opticks' federal registration is not a defense in this case since, as the district court found, the partnership was a prior user of the term "Vision Center" in the New Orleans market area. *See Burger King v. Hoots,* 403 F.2d 904 (7th Cir. 1968).

ly registerable or protectable.[9] *American Heritage Life Ins. Co. v. Heritage Life Ins. Co.,* 494 F.2d 3, 10 (5th Cir. 1974). To assist in making this determination, the courts have traditionally divided the universe of potential trade names into various categories of legal protectability. A trade name is generally classified as being either (1) generic, (2) descriptive, (3) suggestive, or (4) arbitrary or fanciful.[10] *Miller Brewing Co. v. G. Heilman Brewing Co.,* 561 F.2d 75, 79 (7th Cir. 1977), *cert. denied,* 434 U.S. 1025, 98 S.Ct. 751, 54 L.Ed.2d 772 (1978); *Abercrombie & Fitch Co. v. Hunting World, Inc.,* 537 F.2d 4, 9 (2d Cir. 1976); *American Heritage, supra,* 494 F.2d at 11. Although these categories are meant to be mutually exclusive, they are spectrum-like and tend to merge imperceptibly from one to another. For this reason, they are

9 Louisiana law defines a trade name to be "a word, name, symbol, device or any combination thereof used by a person to identify his business, vocation or occupation and distinguish it from the business, vocation, or occupation of others." La.R.S. 51:211. The mere registration of a trade name does not grant the registrant any substantive rights but confers only procedural advantages. *Buyers & Traders Service, Inc. v. Car Maintenance Specialists,* 290 So.2d 753 (La.App. 1974); *Gallo v. Safeway Brake Shops,* 140 So.2d 912 (La.App. 1962). Although the Secretary of State's decision regarding the registerability or protectability of a particular mark is persuasive, his determination is not conclusive or binding on this court. *Couhig's Pestaway Co. v. Pestaway, Inc.,* 278 So.2d 519 (La.App. 1973). The Louisiana trademark statute specifically authorizes the courts to order cancellation of a registered mark when they deem that registration to have been improvidently granted. La.R.S. 51:219.

10 Although no Louisiana case has employed this precise classification scheme, both the district court below and the parties here utilized it in analyzing this case. For this reason, and because we do not think the Louisiana courts would question the usefulness of the categories or reject the parties' reliance on them, we adopt the classification scheme as an aid in measuring the legal protectability of the "vision center" name.

difficult to define and, quite frequently, difficult to apply. *Miller Brewing Co. v. G. Heilman Brewing Co., supra,* 561 F.2d at 79.

A generic term is the name of a particular genus or class of which an individual article or service is but a member. Most courts hold that a generic term is incapable of achieving trade name protection. A descriptive term[11] identifies a characteristic or quality of an article or service and, though ordinarily not protectable, may become a valid trade name if it acquires a secondary meaning. A suggestive term suggests, rather than describes, a characteristic of the goods or services and requires an effort of the imagination by the consumer in order to be understood as descriptive. *General Shoe Corp. v. Rosen,* 111 F.2d 95, 98 (4th Cir. 1940). A suggestive term requires no proof of secondary meaning in order to receive trade name protection. An arbitrary or fanciful term bears no relationship to the

11 Some courts see little difference between the generic and the descriptive categories and tend to meld the two concepts into one. *American Heritage Life Ins. Co. v. Heritage Life Ins. Co., supra,* 494 F.2d at 11; *but see Aloe Creme Laboratories, Inc. v. Milsan,* 423 F.2d 845, 849 (5th Cir.), *cert. denied,* 398 U.S. 928, 90 S.Ct. 1818, 26 L.Ed.2d 90 (1970). As one commentator has noted, the distinction between descriptive and generic terms is necessarily one of degree. R. Callman, *The Law of Unfair Competition, supra,* §70.4. The practical significance of the distinction is seen in the courts' refusal to allow proof of secondary meaning to elevate generic, as opposed to descriptive, terms to trademark status. As noted below, however, under Louisiana law a plaintiff depending on the secondary meaning of his mark must prove fraud or unfair competition before the court will enjoin the defendant's use. This unorthodox construction results in the practical elimination of the generic/descriptive dichotomy, since neither the owner of the generic mark nor the owner of the descriptive mark may rely solely on secondary meaning to achieve trade name protection.

product or service and is also protectable without proof of secondary meaning.

The partnership urges, and the district court found, that "The Vision Center" name is suggestive and therefore entitled to full trade name protection without proof of secondary meaning. We are convinced, however, that the trade name "Vision Center" is descriptive[12] of a clinic providing optical goods and services, and we hold that the partnership has failed to prove secondary meaning as required under Louisiana law. For these reasons, we reverse.

We begin with the proposition that "[t]he concept of descriptiveness must be construed rather broadly" 3 R. Callman, *The Law of Unfair Competition, Trademarks and Monopolies,* §70.2 (3d ed. 1969). Whenever a word or phrase naturally directs attention to the qualities, characteristics, effect, or purpose of the product or service, it is descriptive and cannot be claimed as an exclusive trade name. *Id.* at §71.1. Webster's Third New Inter-

12 We are unable to agree with Opticks that the phrase "vision center" is a generic term. Although the phrase is descriptive of a business that deals in optical goods, we do not think that it has become a common, recognized name of such establishments. In connection with this litigation, Opticks has offered to have its federal registrations cancelled if we will find that these words are generic. While this court is neither disposed nor authorized to bargain with legal rights, we note that in reality Opticks has provided us with no quid pro quo in this case. Under the Lanham Act, if a registered mark becomes the "common descriptive name" of an item (i.e., becomes generic) it may be cancelled at any time. 15 U.S.C. §1064. Therefore, if we were to find that the phrase is generic we would not need Opticks' permission to cancel its mark.

national Dictionary (1964)[13] defines the word "vision" as

> the act or power of seeing; visual sensation or the capacity for it.

The word "center" means

> a concentration of requisite facilities for an activity, pursuit, or interest along with various adjunct conveniences [e.g. shopping center, medical center, amusement center].

Used in combination, the words imply a place where there is a concentration of requisite facilities relating to the power of seeing or the capacity for it. Because the name does not require "imagination, thought and perception to reach a conclusion as to the nature of the goods" or services, it cannot be considered a suggestive term. *Stix Products, Inc. v. United Merchants & Mfrs., Inc.*, 295 F.Supp. 479, 488 (S.D.N.Y. 1968).

Another test used by the courts to distinguish between descriptive and suggestive marks is "whether competitors would be likely to need the terms used in the trademark in describing their products." *Union Carbide Corp. v. Ever-Ready, Inc.*, 531 F.2d 366, 379 (7th Cir.

13 "The dictionary definition of the word is an appropriate and relevant indication 'of the ordinary significance and meaning of words' to the public." *American Heritage Life Ins. Co. v. Heritage Life Ins. Co., supra*, 494 F.2d at 11.

1976). We agree with Opticks that the word "vision" is virtually indispensable to the vocabulary of the optical goods industry.[14] This word, along with such common nouns as eye, sight, and optics, naturally occurs to one in thinking of the goods and services provided by the parties. Similarly, the word "center" is a common term found useful by a variety of commercial enterprises.

We are, of course, aware that common, ordinary words can be combined in a novel or unique way and thereby achieve a degree of protection denied to the words when used separately. Although examining a trade name's individual words in isolation entails the risk that the distinctiveness of the words in combination will be overlooked, we are not guilty of such an oversight here. Rather, whether the words "vision" and "center" are examined together or separately, we are convinced that they lack the quality of inventiveness and imaginativeness characteristic of suggestive trade names.

Yet another barometer of the descriptiveness vel non of a particular name is the extent to which it has been used in the trade names of others offering a similar service or product. *Shoe Corp. of America v. Juvenile Shoe Corp.*, 266 F.2d 793, 796 (C.C.P.A. 1959). As the record reveals, the name "vision center" has been adopted by a large number of optical stores in other parts of the

14 We note that the word has been utilized in the trade name of another optical store in New Orleans, the Vision Plaza.

nation.[15] That the partnership is the only one to use the term in New Orleans does not preclude us from finding that its name is descriptive.

A number of federal and state cases construing similar trade names are consistent with our decision. In *Car Care, Inc. v. D. H. Holmes Co.*, 160 So.2d 272 (La.App. 1964), a Louisiana case, plaintiff sought to enjoin the defendant's use of the name "D. H. Holmes Car Care Center" as an infringement of its name, "Car Care Center." The court concluded that the words "car care" were descriptive of the automobile maintenance business and therefore incapable of exclusive appropriation. In *Surgicenters of America, Inc. v. Medical Dental Surgeries Co.*, 196 U.S.P.Q. 121 (D.Or. 1976), plaintiff claimed that the defendant's use of the name "Medical Dental Surgicenter" infringed its federally registered mark, "Surgicenter." The court disagreed and held that "Surgicenter" was a generic term which should not be given trade name protection. *See also In re Executone Inc.*, 191 U.S.P.Q. 57 (C.C.P.A. 1976) ("Nerve Center"); *Johnson & Johnson v. Saxton Adhesive Products, Inc.*, 185 U.S.P.Q. 245 (C.C.P.A. 1974) ("Tape Center"); *Allens Drug Co. v. Henry B. Gilpen Co.*, 180 U.S.P.Q. 327 (C.C.P.A. 1973) ("Drug Center"); *Houston v. Berde*, 211 Minn. 528, 2 N.W.2d 9 (1942) ("Food Center").

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15 *E.g.*, Royal Vision Center, Chicago Vision Center, Vision Center and Optical Clinic of Baton Rouge, Vision Center Opticians, Professional Vision Center, Vision Center of South Boston, Vision Center at Harvard Square, Plymouth Vision Center, Konrad Vision Center, Total Vision Center, Belmont Vision Center, Livonia-Mall Vision Center, V.I.P. Vision Center, American Vision Center, United Vision Center, 20/20 Vision Center, Plain Vision Center and Harvey Rubin Vision Center.

The partnership questions the applicability of these cases and attempts to distinguish them on the ground that, unlike here, their identifying words describe the goods or services provided by their respective establishments. In order to more precisely identify the service provided by an optical store, the partnership's name should read "Vision *Care* Center."[16] While this may be regarded as the *full* name of such an establishment, to pretend that the abbreviated name "Vision Center" cannot substitute in its stead ignores our "universal habit of shortening full names — from haste or laziness or just economy of words." Application of *Abcor Development Corp.*, 588 F.2d 811 (C.C.P.A. 1978) (Rich, J., concurring). It simply does not require an effort of the imagination to decide that a "vision center" is a place where one can get glasses. Consequently, we find either name to be descriptive of the service provided by a business that deals in optical goods.[17]

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16 The descriptive nature of this term is, of course, beyond peradventure.

17 As evidence that its chosen trade name is distinctive and not generic or descriptive, the partnership points out that a patient in need of eye care is unlikely to say or think, "I am going to my vision center." This reasoning is unacceptable. Few consumers would call a grocery store a "food center" or a pharmacy a "drug center," yet these names have been held descriptive of the establishment's identity. Thus, the fact that "vision center" is not the only or most common name for an optical goods store is not determinative, for "there is no legal foundation that a product has only one common descriptive name." *Roselux Chemical Co. v. Parsons Ammonia Co.*, 299 F.2d 855 (C.C.P.A. 1962). Also, "the absence of a word or expression from dictionaries is not controlling on the question of registerability." *In re Cooper*, 196 U.S.P.Q. 182 (1977).

IV.

The case law uniformly requires that we refuse trade name protection to a descriptive term unless it has acquired a secondary meaning.[18] In order to establish secondary meaning the plaintiff "must show that the primary significance of the term in the minds of the consuming public is not the product but the producer." *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 118, 59 S.Ct. 109, 113, 83 L.Ed. 73 (1938). The burden of proof rests at all times with the plaintiff, and "[a] high degree of proof is necessary to establish secondary meaning for a descriptive term." R. Callman, *The Law of Unfair Competition, supra*, §77.3 at 359; *American Heritage, supra*, 494 F.2d at 12.

Most courts hold that once the plaintiff establishes secondary meaning he need only show a likelihood of confusion in order to enjoin an infringing use. *E.g., Aloe Creme Laboratories, Inc. v. Milsan, Inc.*, 423 F.2d 845 (5th Cir. 1970); R. Callman, *The Law of Unfair Competition, supra*, §77.1. The Louisiana courts, however, continue to hold that the plaintiff who depends on secondary meaning for his trade name cannot obtain injunctive relief unless he proves fraud or unfair competition on the part of the defendant. *Home Beverage Service v. Baas*, 210 La. 873, 28 So.2d 481, 484 (1946); *Straus Frank Co. v. Brown*, 246 La. 999, 169 So.2d 77 (1964); *Couhig's Pest-*

18 "The terms, primary and secondary, may be somewhat misleading since a secondary meaning entitled to protection must have become the primary meaning to the consumer." *Aloe Creme Laboratories, Inc. v. Milsan, Inc., supra*, 423 F.2d at 848 n. 9.

away Co. v. Pestaway, Inc., 278 So.2d 519 (La.App. 1973). Under this rule, the law of unfair competition effectively swallows up the secondary meaning doctrine. Although *Callman* expressly disapproves of the Louisiana case law and considers it erroneous, we are not at liberty to do so.[19]

The partnership, however, relies on the district court's finding that Opticks' conduct amounted to or was at least tantamount to fraud. The Louisiana courts have "always been reluctant to presume fraud." *Straus Frank Co. v. Brown, supra*, 169 So.2d at 80. In the *Straus Frank* case the plaintiff, operating under the trade name "Lake Auto Parts," sued to enjoin the defendant from using the name "Lake Auto Supply." The court observed:

> One other charge leveled at defendant is that he knew of plaintiff's trade name and by adopting a similar one it may be inferred his motive was fraudulent. But we are not convinced of this. To the contrary, aside from the words "Auto Supply" which describes his business, we feel defendant was motivated by the geographical location in the selection of the name Lake Auto Supply, situated as the business is in the town of Lake Arthur which lies on the shores of Lake Arthur.

19 R. Callman, *The Law of Unfair Competition, supra*, §77.1. The Louisiana courts are not unaware of the controversy surrounding the requirement that the plaintiff who relies on secondary meaning prove fraud. *See Straus Frank Co. v. Brown*, 246 La. 999, 109 So.2d 77 (1964).

169 So.2d at 81. Having used the "vision center" trade name for many years in connection with its network of similar stores and its national advertising campaign, Opticks has a significant investment in the name. It was predictable that Opticks would choose to use the name "Pearle Vision Center" in New Orleans. The emphasis placed on the word "Pearle"[20] further absolves Opticks from any charge of deception or unfair competition, and under Louisiana law the addition of this identifying prefix is legally sufficient to distinguish Opticks' business from the partnership's.[21] *Home Beverage Service v. Baas, supra; Couhig's Pestaway Co. v. Pestaway, Inc.*, 278 So.2d 519 (La.App. 1973). We are convinced that the district court's finding of fraud was incorrect.

As the above discussion indicates, even if we were to concede that the partnership's name had acquired a secondary meaning we could not prevent the fair use of the descriptive term "vision center." *Home Beverage Service v. Baas, supra.* We are convinced, however, that the partnership failed to shoulder the substantial evidentiary burden necessary to establish the secondary meaning of this descriptive name.

20 Although we hold that Opticks is free to use the words "vision center" in New Orleans, the corporation is obligated "to identify its product lest it be mistaken for that of the plaintiff". *Kellogg Co. v. National Biscuit Co.*, 305 U.S. at 120, 59 S.Ct. at 114. Opticks, therefore, must honor its pledge to place the identifying prefix "Pearle" in front of the phrase "Vision Center" on all its signs and advertisements in the New Orleans area.

21 The prefix is not only legally sufficient but is legally necessary in order to distinguish Opticks' business and prevent unfair competition. For this reason, Opticks should desist from listing its establishment in the telephone directory under the heading "Vision Center Pearle—See Pearle Vision Center." *See Home Beverage Service v. Baas, supra*, 28 So.2d at 486, where the court, in finding no likelihood of confusion between plaintiff's Home Beverage Service name and defendant's Victory Home Beverage Service name, noted that the defendant listed its name only under the letter "V" in the telephone directory and not under the letter "H."

In assessing a claim of secondary meaning,

> the chief inquiry is the attitude of the consumer toward the mark; does it denote to him a, "single thing coming from a single source"? Short of a survey, this is difficult of direct proof.

Aloe Creme Laboratories, Inc. v. Milsan, Inc., supra, 423 F.2d at 849. The partnership presented no evidence involving an objective survey of the public's perception of its name. Instead, the only evidence offered to show secondary meaning was the testimony of seven of the partnership's customers that "Vision Center" meant the partnership's business to them, testimony that the partnership had occasionally received mail addressed to other establishments that had "vision" in their name, and evidence that a customer of one of Opticks' stores in another city believed the partnership and Opticks were associated.

We think this evidence falls short of establishing that in the minds of the consuming public the *primary* significance of the term "vision center" is "not the product but the producer." Additionally, the recognition of the partnership's long use of the term does not require a different result since the "courts have summarily re-

jected claims of secondary meaning predicated solely upon the continued use of the mark for many years."[22] R. Callman, *The Law of Unfair Competition, supra,* §77.3.

V.

We now address, perhaps somewhat belatedly, the partnership's assertion that Opticks' federal registration of the words "vision center" is prima facie evidence that the name is distinctive and not generic or descriptive. The partnership finds itself in the unusual posture of asserting the validity of Opticks' federal registration, while Opticks, instead of seeking to defend its mark, challenges its initial registerability or protectability. Assuming arguendo that the prima facie evidence provision of the Lanham Act was designed to benefit the partnership in this case, we nevertheless adhere to our conclusion that the "vision center" name is merely descriptive.

Although a statutory presumption of validity is accorded to marks registered under the Lanham Act, 15 U.S.C. §§1057(b), 1115(a), this presumption is rebuttable and may be overcome by establishing the generic or descriptive nature of the mark. *Flexitized, Inc. v. National Flexitized Corp.*, 335 F.2d 774, 779 (2d Cir. 1964), *cert. denied*, 380 U.S. 913, 85 S.Ct. 899, 13 L.Ed.2d

22 The partnership has used the "Vision Center" name in New Orleans for over 20 years. During most of this period, however, it was precluded by the ethics of the profession from engaging in media advertising. Although extensive advertising would not have assured the partnership's success, this circumstance no doubt significantly affected its efforts to develop a secondary meaning for its name.

799 (1965). The partnership maintains that Opticks failed to show that the name is descriptive. We disagree. Our previous discussion indicates that in this case Opticks has argued persuasively, not merely with equal force, that the partnership's name is a term descriptive of the products and services provided by an optical store. *Aluminum Fabricating Co. v. Season-All Window Corp.*, 259 F.2d 314, 316 (2d Cir. 1958); *Scientific Applications, Inc. v. Energy Conservation Corp.*, 436 F.Supp. 354, 360 (N.D.Ga. 1977). The weight of these arguments is more than sufficient to rebut the prima facie presumption that the name is suggestive rather than merely descriptive.

VI.

Because the partnership has not shown a substantial likelihood that it would ultimately prevail on the merits, it is not entitled to the extraordinary relief of a preliminary injunction. We find it unnecessary to engage in a discussion of the other three criteria, except to note that the partnership has also not shown that the injury it will suffer by denying the injunction outweighs the damage that Opticks will suffer if the injunction is granted.

We reverse the district court and remand with instructions that the court dissolve the preliminary injunction and issue an order requiring Opticks to place the identifying prefix "Pearle" before the phrase "Vision Center" on all its signs and advertisements in the New Orleans area.

REVERSED AND REMANDED.

APPENDIX "B"

UNITED STATES COURT OF APPEALS
FOR THE FIFTH CIRCUIT

OCTOBER TERM, 19

No. 78-2867

D.C. Docket No. CA 78-2458 "E"

THE VISION CENTER,
Plaintiff-Appellee,
Cross-Appellant,

versus

OPTICKS, INC., WILL ROSS, INC.
and G. D. SEARLE & CO.,
Defendants-Appellants,
Cross-Appellees.

Appeal from the United States District Court for the
Eastern District of Louisiana

Before THORNBERRY, AINSWORTH and MORGAN, Circuit Judges.

JUDGMENT

This cause came on to be heard on the transcript of the record from the United States District Court for the Eastern District of Louisiana, and was argued by counsel;

ON CONSIDERATION WHEREOF, It is now here ordered and adjudged by this Court that the order of the District Court appealed from, in this cause be, and the same is hereby, reversed; and that this cause be, and the same is hereby remanded to the said District Court in accordance with the opinion of this Court;

It is further ordered that the plaintiff-appellee pay to the defendants-appellants the costs on appeal, to be taxed by the Clerk of this Court.

May 23, 1979

ISSUED AS MANDATE: AUG. 9, 1979

APPENDIX "C"

UNITED STATES COURT OF APPEALS
FOR THE FIFTH CIRCUIT

No. 78-2867

THE VISION CENTER,
Plaintiff-Appellee,
Cross-Appellant,

versus

OPTICKS, INC., WILL ROSS, INC.,
and G. D. SEARLE & CO.,
Defendants-Appellants,
Cross-Appellees.

Appeals from the United States District Court for the Eastern District of Louisiana

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ON PETITION FOR REHEARING

(August 1, 1979)

Before THORNBERRY, AINSWORTH and MORGAN, Circuit Judges.

PER CURIAM:

IT IS ORDERED that the petition for rehearing filed in the above entitled and numbered cause be and the same is hereby Denied.

ENTERED FOR THE COURT:

/s/ ROBERT AINSWORTH, JR.
United States Circuit Judge

APPENDIX "D"

THE VISION CENTER,
Plaintiff,

versus

OPTICKS, INC., WILL ROSS, INC.,
and G. D. SEARLE & CO.,
Defendants.

Civ. A. No. 78-2458

United States District Court
E.D. of Louisiana

Aug. 25, 1978

MOTION FOR PRELIMINARY INJUNCTION

CASSIBRY, District Judge:

INTRODUCTION

This is an action for injunctive relief by The Vision Center, a Louisiana partnership, against Opticks, Inc., a Texas corporation with its principal place of business in Dallas, Texas; Will Ross, Inc., a Delaware corporation with its principal place of business in Milwaukee, Wisconsin and G. D. Searle & Co., a Delaware corporation with its principal place of business in Skokie, Illinois. Plaintiff seeks to enjoin defendants from using the words "Vision Center" in the name of three places of business about to be opened in the Greater New Orleans area under the name "Pearle Vision Center."

The action was originally filed in state court and was removed by the defendants to federal court on the basis of diversity of citizenship of the parties and the required jurisdictional amount involved. The court has jurisdiction by virtue of citizenship of the parties. 28 U.S.C. §1332.

Plaintiff's demand for a preliminary injunction was tried by this court on August 10 and 11, 1978.

Having heard the evidence presented at trial, having reviewed the documents, photographs and other items introduced as exhibits, and having considered the arguments of counsel, I make the following findings of fact and conclusions of law:

FINDINGS OF FACT

1. Plaintiff, The Vision Center, is a Louisiana partnership organized pursuant to Articles of Partnership, dated September 15, 1967, effective as of October 1, 1967.

2. The trade name, "The Vision Center," has been in continuous and uninterrupted use in the Greater New Orleans area since May, 1955 — a period of over twenty-three years — by plaintiff and its predecessor.

3. The first use of the trade name, "The Vision Center," in the New Orleans area was by Dr. Ellis Pailet, plaintiff's managing partner, who commenced using that name in May, 1955, as a sole proprietor engaged in the practice of optometry. Subsequently, Dr. Pailet hired other optometrists to work for The Vision Center, and, in September, 1967, he granted partnership status to some of the salaried optometrists. Pursuant to the Articles of Partnership, the partnership carried on the name, "The Vision Center." The partnership thereafter and without interruption continued, and still continues, the practice of optometry under that name.

4. The trade name, "The Vision Center," was first registered by Dr. Ellis Pailet with the Secretary of State of Louisiana under the Louisiana Trademark Law (R.S. 51:211 *et seq.*) on April 19, 1955. The registration was renewed on March 29, 1965, and again on February 14,

1975. The cost of the last renewal was borne by the plaintiff partnership.

5. The Vision Center, since its inception as a sole proprietorship in 1955, and from 1967 as a partnership, until the current time, placed its name before the public to the maximum extent allowed by the ethics of the optometric profession by use of eyeglass cases, lens wipers, lens cleaning solution, announcements of office openings, telephone book yellow pages, recall notices, letterheads, birthday cards, business cards, appointment notices, statements, other direct mailings and signs on and in front of offices. Over the years, The Vision Center has spent considerable sums on such items, and in the year 1977 alone spent over $30,-000 for that purpose.

6. In 1978, since media advertising became permissible by optometrists, The Vision Center has advertised on radio and in newspapers and magazines. The Vision Center has, so far during the year 1978, spent about $15,000 for such "media advertising."

7. Plaintiff's volume of business has grown over the years and it has succeeded in expanding from one to six offices, with offices now located at 3901 Veterans Boulevard, Metairie, Jefferson Parish, Louisiana; 4301 Elysian Fields Avenue in the Gentilly section or neighborhood of New Orleans; 9235 Lake Forest Boulevard in the Eastern section of New Orleans; 2901 General De Gaulle Drive, in the Algiers section of New Orleans;

Uptown Square, in the uptown section of New Orleans and Hammond Square, Hammond, Tangipahoa Parish, Louisiana.

8. Plaintiff is planning to expand its offices to: Slidell, St. Tammany Parish, Louisiana; Laplace, St. John the Baptist Parish, Louisiana; and to the Central Business District in New Orleans.

9. Plaintiff's market area includes the Louisiana Parishes of Orleans, Jefferson, St. Bernard, Plaquemines, St. Tammany, Tangipahoa, St. Charles and St. John the Baptist.

10. Plaintiff is engaged in the practice of full scope optometry which includes complete visual analysis (including external and internal diagnosis of eye disease, and refractions) and includes dispensing of eyeglasses, contact lenses, eyeglass frames and other visual aids, and all things which optometrists are permitted by law to do.

11. The nature of plaintiff's profession is such that many patients seek out plaintiff as a result of patient and professional referrals. These referrals are normally made to "The Vision Center" or "Vision Center," rather than to a particular optometrist. However, when referrals are made to a particular optometrist, generally, the connection is made to identify that practitioner as a part of plaintiff's office (*e.g.*, "See Dr.

_____ at 'The Vision Center,' or at 'Vision Center' ").

12. Plaintiff has over the years obtained and presently obtains patients from its listings in the telephone book yellow pages and from signs on and in front of its offices.

13. During 1978, plaintiff's media advertising of its name has attracted business.

14. Plaintiff's name, "The Vision Center," is well established and is, and has been, well known to the public in its market area for over twenty-three years.

15. No one else in plaintiff's market area uses the combination of the words "Vision" and "Center."

16. There have been instances of confusion between plaintiff's name and the name of others in similar businesses using only the word "Vision" as part of the trade name, including mail being delivered to the wrong place; *e.g.*, such confusion with "Vision Plaza."

17. There has been confusion between plaintiff's business and certain of defendants' Pearle Vision Centers; *e.g.*, there was actual confusion in the mind of a witness who confused defendants' Biloxi, Mississippi facility as being a "Vision Center" connected with plaintiff, and there was confusion by someone who

tried to have plaintiff, The Vision Center, honor an eyeglass guarantee of defendants' Pearle Vision Center.

18. Plaintiff's partners first heard rumors that defendants may be opening facilities in the New Orleans area in August, 1977 and, through its attorney, wrote to defendants asking if this were the case. In March, 1978, defendants responded to that inquiry and informed plaintiff that they did intend to open such facilities.

19. By letter dated May 25, 1978, plaintiff, through its attorney, made formal demand on defendants not to use both the words "Vision" and "Center" in its trade name in plaintiff's market area, and by letter of June 21, 1978, plaintiff's attorney made a follow-up demand on defendants therefor.

20. Defendant G. D. Searle & Company is the parent corporation of defendants Will Ross, Inc., and Opticks, Inc. Opticks is considered Searle's "Optical Group" and is doing business under the names Vision Center, Pearle Vision Center, and other Vision Centers.

21. In 1969 Opticks, Inc., acquired a New York City company which had done business since 1952 under the name "Vision Center." This company continued to

dispense optical equipment and services after its acquisition by Opticks, Inc.

22. Shortly after the acquisition, Opticks, Inc., began operating similar stores in other areas of the country using the words "vision center" as a trade name or in combination with a prefix.

23. In 1969 Opticks, Inc., was merged into Will Ross, Inc.

24. On July 28, 1970 Will Ross, Inc., registered the words "Vision Center" as a service mark in the principal register of the United States Patent & Trademark Office (No. 895,663). On November 17, 1975 affidavits pursuant to Section 8 and Section 15 of the Lanham Act were filed and accepted with respect to the service mark.

25. On July 13, 1971 Will Ross, Inc., registered the words "Vision Center" as a trademark on the principal register of the U.S. Patent Office (No. 916,280). On November 23, 1976 a Section 15 Affidavit was filed with the U.S. Patent Office with respect to the trademark. On October 5, 1976 a Section 8 Affidavit was accepted by the U.S. Patent Office with respect to the trademark.

26. Opticks, Inc., was recently spun off as a separate corporate entity, and Service mark No. 895663

and Trademark No. 916,280 were assigned by Will Ross, Inc., to Opticks, Inc., as recorded in the U.S. Patent Office on October 1, 1977.

27. Defendant Opticks, Inc., owns and operates over 300 retail outlets for optical goods and services throughout the United States under the trade names "PEARLE Vision Center," "ROGERS Vision Center," and "HILLMAN-KOHAN Vision Center."

28. Defendants use, anywhere, of the words "Vision Center" as part of a trade name was subsequent to plaintiff's use of the words "The Vision Center" as a trade name — plaintiff and its predecessors having used it since May, 1955.

29. Defendants have not heretofore used the words "Vision Center" as part of a trade name in the plaintiff's market area.

30. Defendants are in the business of selling optical goods such as eyeglass frames and lenses, and employ opticians to fit and sell such eye-wear goods.

31. Defendants use eyeglass cases with only the words "Vision Center" within an oval imprinted on them. Plaintiff, since its inception and since the inception of its predecessor, has used, and now uses, eyeglass cases containing the words "The Vision Center." Defendants have not shown any intention to change their use of such eyeglass cases.

32. Defendants conduct national advertising using only the words "Vision Center" in magazine advertisements, in television commercials (*e.g.*, now in Atlanta, Georgia, the television commercial uses just "Vision Center" more than once in the middle of it, and "Pearle Vision Center" at the end), on store signs, and in some of defendants' eyeglass warranty (guarantee) certificates.

33. Opticks, Inc., plans to open three outlets in the New Orleans area under the trade name "Pearle Vision Center" in the near future.

34. Defendants are locating their facilities as follows:

(a) One at 3544 Veterans Boulevard, Metairie, Louisiana, just six-tenths (0.6) of a mile from plaintiff's office located on the same street at 3901 Veterans Boulevard, Metairie, Louisiana;

(b) One at 4801 Chef Menteur Highway in the Gentilly section of New Orleans, just one and six-tenths (1.6) miles from plaintiff's Gentilly office located at 4301 Elysian Fields Avenue, New Orleans;

(c) One at 1523 Tulane Avenue, New Orleans, just three and eight-tenths (3.8) miles from plaintiff's Elysian Fields office.

35. The opening of the "Pearle Vision Center" stores will be extensively advertised on local television, radio, in newspapers, and in direct mail flyers.

36. Each Pearle Vision Center location will have a large exterior sign showing the company name in large white letters on a green background. One sign, for example, will be 28 ft. wide by 8½ ft. high. The word "Pearle" will be in white letters 33 inches high and directly below it will be the words "Vision Center" in 19 inch white letters.

37. Defendants have known of plaintiff's existence in New Orleans for many years.

38. Defendants, through one of the defendants' real estate departments, conducted a market survey of the New Orleans area prior to entering the market.

39. Prior to entering the market and expending funds in connection therewith, defendants knew of the locations of plaintiff's offices and knew that plaintiff intended to assert its rights to protect its name.

40. The combination of the words, or the phrase, "The Vision Center," *i.e.*, plaintiff's trade name, is not generic or descriptive.

41. Plaintiff's trade name is suggestive of the business it is engaged in. It has come to be well known in

plaintiff's market area by reason of its long usage of the name in the market, the valuable goodwill of the name and the identification of the name with plaintiff's business.

42. Even if plaintiff's trade name were descriptive, the evidence is clear that the trade name has acquired a secondary meaning, because after long use (twenty-three years) in the market area, the public has come to identify and associate the trade name with the plaintiff, and not with the services plaintiff renders. The words "The Vision Center" have come to mean in the minds of the public, the identity of plaintiff.

43. Actual confusion has been shown to exist between plaintiff's offices and some of defendants' facilities which are outside plaintiff's market area.

44. Actual confusion has been shown to exist between plaintiff's offices and other similar local offices using just the word "Vision" in the name.

45. There was uncontradicted testimony by independent witnesses that they would confuse defendants' new establishments to be called "Pearle Vision Center" and plaintiff's offices.

46. Persons who would go to The Vision Center by referrals or by reason of advertisements would be confused because of the similarity in names between plaintiff's, The Vision Center, and defendants', Pearle Vision Center, particularly since the locations established by defendants are in such close proximity to plaintiff's existing offices.

47. The use of the word combination of "Vision Center" by defendants in connection with their optical stores in the Greater New Orleans area is likely to cause confusion to the public and cause plaintiff to lose business.

48. Sometime ago, defendants initiated negotiations with plaintiff's partners to purchase The Vision Center.

49. The facts hereinabove set forth clearly establish that defendants are attempting to compete unfairly with plaintiff and to infringe upon plaintiff's long-established trade name and goodwill, some of which are: (i) defendants knew of plaintiff's long use of its trade name in the market; (ii) defendants attempted to purchase plaintiff's business; (iii) defendants obviously had knowledge of the value of plaintiff's long-established name and goodwill; (iv) defendants have and/or are locating their new facilities in plaintiff's market area (even on the same street and in the same neighborhood); and (v) the public already has been confused by defendants' out-of-the-market locations doing business as Pearle Vision Center.

50. The defendants have not successfully shown that the harm of an injunction to them outweighs the threatened injury to plaintiff.

CONCLUSIONS OF LAW

1. Plaintiff, as first user of the trade name "The Vision Center" in its market area, has established a priority of appropriation in that market area. *Handy v. Commander,* 49 La.Ann. 1119, 22 So. 230 (1897); *Dynasty Room, Inc. (d/b/a Whiskey-A-Go-Go) v. Whiskey-A-Go-Go, Inc.,* 186 So.2d 402 (La.App. 4th-1966); and *Gallo v. Safeway Brake Shops of Louisiana, Inc.,* 140 So.2d 912 (La.App. 4th-1962).

2. By virtue of plaintiff's prior appropriation of the trade name and because a federal trademark and use of such trade name or mark in other locations cannot displace a locally acquired trade name, plaintiff has a proprietary interest in and a superior right to the trade name in its market area. *Dynasty Room, Inc.(d/b/a Whiskey-A-Go-Go) v. Whiskey-A-Go-Go, Inc.,* 186 So.2d 402 (La.App. 4th-1966); *American Trading Co. v. H. E. Heacock Co.,* 285 U.S. 247, 52 S.Ct. 387, 76 L.Ed. 740 (1932); and *United Drug Co. v. Theodore Rectanus Co.,* 248 U.S. 90, 39 S.Ct. 48, 63 L.Ed. 141 (1919).

3. State law being applicable to this action, the plaintiff is entitled to injunctive relief upon a *prima facie* showing that irreparable injury would result absent

the injunction order. *Albrecht v. Del Bondio,* 188 La. 502, 177 So. 587 (1937); *see also Creppel v. Parish of Jefferson,* 352 So.2d 297 (La.App. 4th-1977), writ denied, La., 354 So.2d 201. However, even if federal trade name law is applied it is clear that plaintiff is entitled to issuance of a preliminary injunction thereunder upon a showing that confusion is possible and likely. *P. Daussa Corp. v. Sutton Cosmetics, Inc.,* 462 F.2d 134 (CA 2-1972).

4. The fact that the United States Patent Office accepted the trade name "Vision Center" for registration on its principal registry is *prima facie* evidence of "the distinctiveness" of "Vision Center" as a trade name. *Abercrombie and Fitch Co. v. Hunting World, Inc.,* 537 F.2d 4, 11 (CA 2-1976); *Union Carbide Corp. v. Ever-Ready, Inc.,* 531 F.2d 366, 378 (CA 7-1976) *cert. denied* 429 U.S. 830, 97 S.Ct. 91, 50 L.Ed.2d 94.

5. I find that plaintiff's trade name is "suggestive" of the services and products it provides and is capable of, and entitled to, full trade-name protection. *Abercrombie and Fitch Co. v. Hunting World, Inc.,* 537 F.2d 4, 11 (CA 2-1976). It does not fall within those names denied trademark protection. The trade name is not generic. It does not name plaintiff's products or services. Nor is it descriptive of plaintiff's products and services.

The definitions of the words "vision" and "center" do not clearly imply a facility or group of facilities related to eye care and its associated products as defendants suggest.

"Vision" is defined as "The act or power of seeing: visual sensation or the capacity for it."

The word "vision" does not imply eye care services or products for the improvement of vision, and adding the word "center" to "vision" does not supply the implication.

The word "center" is defined as:

> "a place, area, person, group or concentration marked significantly or dominatingly by an indicated activity, pursuit, interest or appeal; . . . a concentration of requisite facilities for an activity, pursuit or interest along with various adjunct conveniences . . . [e.g.] shopping center, medical center, amusement center."

6. Plaintiff has established that its trade name has acquired a secondary meaning, and accordingly, plaintiff's trade name, if descriptive, is capable of, and is entitled to, full trade name protection. *Handy v. Commander*, 49 La.Ann. 1119, 22 So. 230 (1897); *Kellogg Company v. National Biscuit Co.*, 305 U.S. 111, 59 S.Ct. 109, 83 L.Ed. 73 (1938); *American Aloe Corp. v. Aloe Cream Laboratories, Inc.*, 420 F.2d 1248 (CA 7-1970), *cert. denied* 400 U.S. 820, 91 S.Ct. 37, 27 L.Ed.2d 47 (1971); *Beef/Eater Restaurants, Inc. v. James Burrough, Ltd.*, 398 F.2d 637 (CA 5-1968); *Safeway Stores, Inc. v. Stephens (d/b/a Save-Way Food Center and Dairy Bar)*, 281 F.Supp. 517 (W.D. La.-1967); *Kelly Girl Services, Inc. v. Roberts*, 243 F.Supp. 225 (E.D. La.-1965).

7. Defendants' federally registered trade name is not incontestable as to plaintiff because plaintiff has established prior appropriation and use in the local market area; therefore plaintiff is entitled to full trade name protection. 15 U.S.C. §1065 (The Lanham Act); *American Trading Co. v. H. E. Heacock Co.*, 285 U.S. 247, 52 S.Ct. 387, 76 L.Ed. 740 (1932); *Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312 (Cust. & Pat.App.-1976).

8. Defendants' use of the term or phrase "Pearle Vision Center" in the Greater New Orleans area amounts to trade name and trade mark infringement and unfair competition; and the public is likely to be, and has been, confused by such use. *Handy v. Commander*, 49 La.Ann. 1119, 22 So. 230 (1897); *Boogie Kings v. Guillory*, 188 So.2d 445 (La.App. 3d-1966), *writ. ref.*, 249 La. 761, 191 So.2d 140 (1966); *American Trading Co. v. H. E. Heacock Co.*, 285 U.S. 247, 52 S.Ct. 387, 76 L.Ed. 740 (1932); *Beef/Eater Restaurants, Inc. v. James Burrough, Ltd.*, 398 F.2d 637 (CA 5-1968); and *Safeway Stores, Inc. v. Stephens (d/b/a Save-Way Food Center and Dairy Bar)*, 281 F.Supp. 517 (W.D.La.-1976).

9. The use of a trade name or a part thereof by a latecomer after receipt of notice from the existing user that such use violated or would violate the existing user's trade name gives rise to a presumption of intent to deceive. *Kelly Girl Services, Inc. v. Roberts*, 243 F.Supp. 225 (E.D. La.-1965).

10. From the facts found, the Court concludes that the conduct of defendants constitutes fraud and that fraud can be "reasonably inferred" from the conduct and practices and proposed conduct and practices of defendants. The conduct and practices of defendants "amount to" fraud and are, at least, "tantamount" to fraud. *Straus Frank Co. v. Brown*, 246 La. 999, 169 So.2d 77 (1964); *T.G.I. Friday's Inc. v. International Restaurant Group, Inc.*, 569 F.2d 895 (CA 5-1978); *T.G.I. Friday's Inc. v. International Restaurant Group, Inc.*, 405 F.Supp. 698 (M.D.La.-1975).

11. The latecomer into the market area, in this case, the defendant, must bear the burden of avoiding confusion, mistake, and deception, and the defendant has failed to meet such a burden. *Telechron, Inc. v. Telicon Corp.*, 198 F.2d 903 (CA 3-1952); *Safeway Stores, Inc. v. Stephens (d/b/a Save-Way Food Center and Dairy Bar)*, 281 F.Supp. 517 (W.D.La.-1967); and *Kelly Girl Services, Inc. v. Roberts*, 243 F.Supp. 225 (E.D.La.-1965).

12. The expenditure of considerable sums of money by plaintiff (i) to advertise its name to the general public, (ii) to protect its acquired goodwill, and (iii) to protect its own exclusive use of its trade name, is a substantial element in the maintaining of its burden of proof, in showing that the issuance of a preliminary injunction is called for, to prevent irreparable injury. *Kelly Girl Services, Inc. v. Roberts*, 243 F.Supp. 225 (E.D. La.-1965); *Beef/Eater Restaurants, Inc. v. James Burrough, Ltd.*, 398 F.2d 637 (CA 5-1968).

13. Plaintiff will suffer irreparable harm and injury if defendants are allowed to commence business using the trade name, "Pearle Vision Center." Since the damages resulting from defendants' use of that name cannot be quantified, no award of damages could properly compensate plaintiff and, therefore, plaintiff has no adequate remedy at law. *P. Daussa Corp. v. Sutton Cosmetics, Inc.*, 462 F.2d 134 (CA 2-1972); *American Trading Co. v. H. E. Heacock Co.*, 285 U.S. 247, 52 S.Ct. 387, 76 L.Ed. 740 (1932); *Handy v. Commander*, 49 La.Ann. 1119, 22 So. 230 (1897); *Dynasty Room, Inc. (d/b/a Whiskey-A-Go-Go) v. Whiskey-A-Go-Go, Inc.*, 186 So.2d 402 (La. App. 4th-1966); *Louisiana Revised Statutes* 51:223.

The plaintiff's motion for preliminary injunction is GRANTED.

Supreme Court, U. S.
FILED
NOV 28 1979
MICHAEL RODAK, JR., CLERK

In the Supreme Court of the United States

OCTOBER TERM, 1979

NO. 79-684

THE VISION CENTER,

Petitioner

VERSUS

OPTICKS, INC., WILL ROSS, INC.
and G. D. SEARLE & CO.,

Respondents

BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

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IN THE
SUPREME COURT OF THE UNITED STATES
OCTOBER TERM, 1979

NO. 79-684

THE VISION CENTER,

Petitioner

VERSUS

OPTICKS, INC., WILL ROSS, INC.
and G. D. SEARLE & CO.,

Respondents

BRIEF IN OPPOSITION TO PETITION
FOR A WRIT OF CERTIORARI TO THE UNITED
STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

STATEMENT OF THE CASE

Petitioner is a partnership formed in 1967 for the practice of optometry in the New Orleans area by Dr. Ellis Pailet and other optometrists. The name "The Vision Center" was first used by Dr. Pailet when he began his practice of optometry in New Orleans in 1955. The words "The Vision Center" or "Vision Center" have been used by petitioner on eyeglass

cases, thank-you notes, birthday cards, annual recall notices, stationery, and business forms given to patients or otherwise used in petitioner's business, and, since a change of the law in 1978, have been used by petitioner in its advertising in newspapers, magazines, and on the radio.

In 1969, Opticks, Inc., a G.D. Searle & Co. subsidiary incorporated in Texas with its principal place of business in Dallas, acquired a New York City company that had dispensed optical goods and services since 1952 under the name "Vision Center". Shortly after this acquisition, Opticks began operating similar stores in other areas of the country using the words "Vision Center," usually with one of three prefixes: "Pearle", "Rogers", or "Hillman-Kohan."

At present, Opticks; Inc. owns and operates a national chain of retail outlets for optical services and goods under the trade names "Pearle Vision Center", "Rogers Vision Center", and "Hillman-Kohan Vision Center." Opticks, Inc. planned to open three outlets in the New Orleans area under the name "Pearle Vision Center" in late August, 1978; each store would have been identified by a large green exterior sign showing the words "Pearle Vision Center" in large white letters, with the word "Pearle" in a legend twice as bold and twice as large as the words "Vision Center". In connection with the opening of its New Orleans stores, Opticks, Inc. planned to use its national advertising program and materials including television and radio commercials, newspaper advertisements, and direct mail fliers. Although a small percentage of consumer-oriented

advertising material used elsewhere in the country employs the words "Vision Center" without an identifying prefix, the advertising slated for use in the New Orleans area always used only the words "Pearle Vision Center."

Petitioner sued respondents in state court in Louisiana for an injunction prohibiting respondents from using their trade name "Pearle Vision Center." Upon removal of the case by respondents, a trial for a preliminary injunction was held in the United States District Court for the Eastern District of Louisiana on August 10-11, 1978. At trial, petitioner offered into evidence national advertising used by respondents in other areas of the country, respondents' telephone listing, testimony from seven of petitioner's customers that "Vision Center" connoted petitioner's business to them, testimony showing occasional receipt by petitioner of mail addressed to other optical goods and services dispensaries with the word "vision" in their names, and evidence that a person who had patronized one of respondents' stores in another city confused respondents with petitioner.

Based on this evidence, the district judge issued a preliminary injunction on August 25, 1978, prohibiting respondents from using the words "vision" and "center" together in any of their signs or advertisements in the New Orleans area. On May 23, 1979, the United States Court of Appeals for the Fifth Circuit reversed the district court and remanded the case for further proceedings not inconsistent with its opinion, printed at 596 F.2d 111 (Appendix A, pp. 1a-9a, petitioner's brief before this Court). Petitioner's petition for rehearing was

denied on August 1, 1979, the mandate of the Court of Appeals issued August 9, 1979, and the district court dissolved the preliminary injunction on August 16, 1979 (see Appendix, *infra).* Petitioner did not bring a motion to stay the mandate of the Court of Appeals. Respondents are now doing business in the New Orleans area under the name "Pearle Vision Center" in accordance with the district court's order.

REASONS FOR REFUSAL OF THE WRIT OF CERTIORARI

I.

The decision of the Court of Appeals, as it relates to likelihood of confusion and secondary meaning, is not in conflict with decisions of this Court, those of other Courts of Appeals, or its own earlier decisions.

The Court of Appeals, holding that petitioner had failed to prove that secondary meaning had attached to the term "vision center", recognized that proof of secondary meaning is a very heavy burden for a plaintiff to carry. *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 118, 59 S.Ct. 109, 113 (1938); *American Heritage Life Insurance Co. v. Heritage Life Co.*, 494 F.2d 3, 12 (5th Cir. 1974); 3 R. Callman, *The Law of Unfair Competition, Trademarks and Monopolies* §77.3, at 359 (3d ed. 1969). In addition, before a plaintiff may enjoin as allegedly infringing use of a mark he must also prove a

"likelihood of confusion", which is difficult of direct proof short of a survey. *Aloe Creme Laboratories, Inc. v. Milsan, Inc.*, 423 F.2d 845, 849 (5th Cir. 1970).

The Court of Appeals held that the testimony of the petitioner's own seven patients, the instances of misdirected mail, and the actual confusion of one of respondent's customers was legally insufficient to establish secondary meaning. The Court noted that the significant investment in the trade name "Vision Center" by respondents for many years in connection with their nationwide advertising campaign and network of optical dispensaries made it predictable that respondents would use the name "Pearle Vision Center" in the New Orleans area. 596 F.2d at 118. In addition, the Court noted, the emphasis placed by respondents on the word "Pearle" in their trade name further absolved them from any charge of deception or unfair competition. *Id.*

Nothing in *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 36 S.Ct. 357 (1916), compels a different result. This Court there held that the substitution of an identifying prefix before a mark was not sufficient to allay the likelihood of confusion, but expressly based this holding upon a finding that the respondent had *deliberately* attempted to trade on the good will of the petitioner, a factor not present in the instant case:

> [Respondent's] purpose to take advantage of the reputation of the [petitioner's] Tea Rose flour is so manifest, and the tendency of the similarity of the brand and accompanying

> design, and of the makeup of the packages, to mislead ultimate consumers, is so evident that it seems to us a case of unfair competition is made out. The circumstances strongly indicate a fraudulent intent to palm off the Steeleville Tea Rose flour upon customers as being the same as the Tea Rose flour made by complainant, the reputation of which is shown to be so well established.

36 S.Ct. at 364. This passage, in fact, immediately preceded the excerpted sentence quoted by petitioner on p. 7 of its brief before this Court. Apart from the obvious difference between "Tea Rose" as applied to flour and "vision center" as applied to an optical goods store, this Court's holding in *Hanover Star Milling Co., supra,* was also based on a finding that the words "Tea Rose" had acquired a secondary meaning. *Id.*

Nor is *World Carpets, Inc. v. Dick Littrell's New World Carpets,* 438 F.2d 482 (5th Cir. 1971), in any way in conflict with the holding of the Court of Appeals below. In that case, the conflicting marks were "World" and "New World", not, as stated on p. 7 of petitioner's brief before this Court, "World Carpets" and "New World Carpets." The Court of Appeals' holding there that the use of the mark "New World" infringed upon the mark "World" was expressly premised upon a holding that the term "World" was not a descriptive term, *contra* the Court's view of the mark "Vision Center" in the instant case. *Id.* at 486-87.

And in *Jenkins Publishing Co. v. Metal Working Publishing Co.*, 315 F.2d 955 (C.C.P.A. 1963), the affirmance by the Court of Customs and Patent Appeals of the cancellation from the Supplemental Register of the mark "Western Metal Working" as infringing upon the mark "Metal Working" was founded upon that court's unquestioning acceptance of the registration of the term "Metal Working" on the Principal Register as conclusive evidence of proof of secondary meaning, an element not present in the instant case. *Id.* at 957.

In sum, the holding below was squarely in accord with the law of trademark infringement as reflected in relevant decisions of this Court, other Courts of Appeals, and the Fifth Circuit Court of Appeals' own prior holdings.

II.

The decision of the Court of Appeals, which recognized that an inherently descriptive term is incapable of trademark protection without secondary meaning, and that such secondary meaning cannot be proved through long usage alone, does not conflict with the decisions of this Court, those of the Courts of Appeals of other Circuits, or its own earlier decisions.

Although petitioner correctly represents on p. 8 of its brief before this Court that the federal registration of a trademark is *prima facie* evidence of the distinctive character of a mark, it fails to point out that this rebuttable statutory presumption of trademarkability under the Lanham Act, 15 U.S.C. §§1057(b), 1115(a)(1976), may be overcome by establishing

the generic or descriptive nature of the mark. *Flexitize, Inc. v. National Flexitize Corp.*, 335 F.2d 774, 779 (2d Cir. 1964), *cert. denied*, 380 U.S. 913, 85 S.Ct. 899 (1965), *cited in Vision Center v. Opticks, Inc.*, 596 F.2d 111, 119 (5th Cir. 1979).

Petitioner's reliance on *American Trading Co. v. H. E. Heacock Co.*, 285 U.S. 247, 52 S.Ct. 387 (1932), is also misplaced. In that case, unlike the present case, the infringing trade name was *identical* to the trade name sought to be protected - - "Wm. A. Rogers, Ltd." - - and the goods covered by the trade name used by both petitioner and respondent were also virtually identical:

> The evidence is conclusive that the wares for which the American Trading Company has been taking and filling orders are very similar in appearance, design, and material to the wares which have been advertised and sold in this country by Heacock Company since 1905. It is true that a dealer in such wares could and would see the distinction between them, but even so, in the ordinary course of business, the average public to whom they are sold could not and would not distinguish one from the other.

Id. at 255, 52 S.Ct. at 389. As a consequence, only one user of the mark could be protected: the addition of an identifying prefix before a descriptive term to eliminate the likelihood of

confusion was simply not an issue there.

In addition, the contention by petitioner that long usage, without more, is legally sufficient to prove secondary meaning is, as this Court has earlier recognized, incorrect. In *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 59 S.Ct. 109 (1938), this Court addressed the contention by a manufacturer of shredded wheat cereal that its long use of the term "shredded wheat" entitled it to the exclusive use of that name in commerce:

> It is contended that the plaintiff has the exclusive rights to the name 'shredded wheat' because those words acquired the 'secondary meaning' of shredded wheat made at Niagara Falls by the plaintiff's predecessor. There is no basis here for applying the doctrine of secondary meaning. The evidence shows only that due to the long period in which the plaintiff or its predecessor were the only manufacturer of the product, many people have come to associate the product, and as a consequence the name by which the product is generally known, with the plaintiff's factory at Niagara Falls. But to establish a trade name in the term 'shredded wheat' the plaintiff must show more than a subordinate meaning which applies to it. It must show that the primary significance of the term in the minds of the consuming public is not the pro-

> duct but the producer. This it has not done. The showing which it has made does not entitle it to the exclusive use of the term 'shredded wheat' *but merely entitles it to require that the defendant use reasonable care to inform the public of its source of its product.*

Id. at 118-19, 59 S.Ct. 113-14 (emphasis added). The holding of the Court of Appeals in the decision below, 596 F.2d at 119, was therefore in harmony with this Court's pronouncement in *Kellogg Co.* that the long, unopposed usage of a term, without more, is legally insufficient to establish secondary meaning.

III.

The requirement that fraud or conduct tantamount to fraud be proved in order to entitle the petitioner to injunctive relief is an integral part of his cause of action under Louisiana law. This requirement was correctly applied by the Court of Appeals in the decision below.

This case was originally filed in state court, and was removed to the United States District Court for the Eastern District of Louisiana on the grounds of the diversity of the citizenship of the parties. Therefore, of course, Louisiana law governed this case. The Court of Appeals for the Fifth Circuit applied Louisiana law, relying also, as do the Louisiana courts, on federal precedents where there is no difference between Louisiana law and the general law.

The Court of Appeals in its decision below properly applied Louisiana law in this case, which requires that, before an allegedly infringing use of a trade name be enjoined, the plaintiff must prove fraud or conduct tantamount to fraud on the part of the defendant. Whatever the difference petitioner postulates between "actual fraud" and "conduct tantamount to fraud", it is clear beyond cavil that the gravamen of this requirement is that petitioner prove that respondents attempted to pass off their own goods and services as his. *T.G.I. Friday's, Inc. v. International Restaurant Group, Inc.*, 569 F.2d 895, 899 (5th Cir. 1978); *Straus Frank Co. v. Brown*, 169 So.2d 77 (La. 1964); *Home Beverage v. Baas*, 28 So.2d 481 (La. 1946).

As the Court of Appeals recognized, the evidence introduced by petitioners at the trial of the preliminary injunction was simply too weak to warrant the extraordinary remedy of injunctive relief. Whatever significance petitioner attaches to the use of large signs by respondents in advertising their business, or their attempts to purchase its business, it cannot be denied that the significant investment in the "Pearle Vision Center" trade name nationwide, and the extensive advertising program devoted to the promotion of that name, makes it more than reasonable to expect that this name would be used in the New Orleans area. Further, the emphasis placed by respondents on the word "Pearle" as opposed to the words "Vision Center", and the fact that the words "Vision Center" were never used in the New Orleans area without the identifying prefix, establish that the conduct of respondents in the New Orleans area did not even approach being fraudulent.

If there exists "a wedge between the law of trade names as enforced throughout the United States from that as enforced in Louisiana", as represented on p. 11 of petitioner's brief before this Court, it is a wedge not placed there by the United States Court of Appeals for the Fifth Circuit. As that Court recognized, 596 F.2d at 118 n.19, the law of Louisiana denies injunctive relief to a plaintiff alleging trademark infringement unless he can prove fraud on the part of the alleged infringer. *Straus Frank Co. v. Brown*, 169 So.2d 77 (La. 1964); *Home Beverage Service v. Baas*, 28 So.2d 481, 484 (La. 1946); *Couhig's Pestaway Co. v. Pestaway, Inc.*, 278 So.2d 519 (La. App. 4th Cir. 1973). The Court recognized that this requirement for injunctive relief is peculiar to Louisiana, but, under the *Erie* doctrine, it of course applied Louisiana law.

CONCLUSION

The complete absence in this case of any of the factors enunciated in Supreme Court Rule 19(1)(b), as well as the obviously judicious consideration of the facts and accurate application of the law by the United States Court of Appeals for the Fifth Circuit, makes this case unworthy of the issuance of a writ of certiorari. As this Court has before stated, "ordinarily we accept and therefore do not review, save in exceptional cases, the considered determination of questions of state law by the intermediate federal appellate courts." *Huddleston v. Dwyer*, 322 U.S. 232, 233, 64 S. Ct. 1015, 1018 (1944). The petition for a writ of certiorari therefore should be denied.

Respectfully submitted,

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CERTIFICATE

It is certified that copies of the foregoing Brief in Opposition to Petition for Writ of Certiorari were served on Petitioner this date by mailing same to their counsel of record as required by Rule 33(1) of this Court.

New Orleans, Louisiana, this 27th day of November, 1979.

Harry S. Hardin, III

APPENDIX

UNITED STATES DISTRICT COURT
EASTERN DISTRICT OF LOUISIANA

THE VISION CENTER	CIVIL ACTION
versus	NO. 78-2458
OPTICKS, INC.; WILL ROSS, INC.; and G. D. SEARLE & CO.	SECTION "E" (4)

MOTION TO DISSOLVE PRELIMINARY INJUNCTION

NOW INTO COURT, through undersigned counsel, come defendants, Opticks, Inc., Will Ross, Inc., and G. D. Searle & Co., who, on representing to the Court that counsel for plaintiff has no objection to the form of this motion, respectfully move this Court for an order in accordance with the mandate issued by the United States Court of Appeals, Fifth Circuit in *Vision Center vs. Opticks, Inc.*, 596 F.2d 111, 120 (5th Cir., 1979).

ORDER

CONSIDERING THE FOREGOING, it is ordered that the Order for Preliminary Injunction entered by this Court on August 25, 1978 be, and the same is hereby, dissolved.

It is further ordered that Opticks, Inc., Will Ross, Inc., and G. D. Searle, & Co., Inc. must place the identifying prefix "Pearle" before the phrase "Vision Center" every time the phrase "Vision Center" appears in any of their signs and ad-

vertisements in the New Orleans area.

New Orleans, Louisiana, August 16, 1978.

s/ Morey L. Sear
JUDGE

RESPECTFULLY SUBMITTED,

s/ Gerald F. Slattery, Jr.

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